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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,507	03/01/2004	Douglas C. Hittle	CSURF-112A	2758
28304	7590	11/06/2008	EXAMINER	
JEAN M. MACHELEDT			WYROZEBSKI LEE, KATARZYNA I	
501 SKYSAIL, LANE			ART UNIT	PAPER NUMBER
SUITE B100			1796	
FORT COLLINS, CO 80525-3133			MAIL DATE	DELIVERY MODE
			11/06/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,507	<b>Applicant(s)</b> HITTLE ET AL.
	<b>Examiner</b> Katarzyna Wyrozebski	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 July 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-16 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

In view of the applicant's response dated 7/22/2008 following office action is final. Applicant's arguments have been considered but not found as persuasive. Applicant's arguments are addressed below. All rejections of record are incorporated here by reference.

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 6, 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SALYER (Re 34,880)

The discussion of the disclosure of the prior art of SAYLER from paragraph 3 of the office action dated 1/22/08 is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over SALYER (US Re 34,880) in view of CHEN (US 4,513,053).

The discussion of the disclosure of the prior art of SALYER and CHEN from paragraph 7 of the office action dated 1/22/08 is incorporated here by reference.

*Response to the Applicant's Arguments*

a) The applicants have argued that the prior art of SALYER does not disclose binder material.

With respect to the applicants arguments, the instant claim 1 that was rejected by the teaching of SALYER requires at least 10% of binder material, without indicating any further limitations as to what this material may actually be. Therefore, binder material can be anything that is capable of satisfying the definition of binder as described in chemical dictionary. It can be solid or liquid, organic or inorganic. Please note that the prior art if SALYER was utilized to reject generic claim and not those specific to applicant's dependent reciting polyesters and epoxy.

In addition, by use of term "comprising" the applicants have not excluded from the scope of their claims vulcanizing agents not compounds that cause vulcanization. Whether vulcanization renders crosslinking irreversible or not, these components are still within the scope of the instant invention.

Applicants continue to argue presence of silica, which is still enabled by use of term "comprising" and that such does not provide any functionality as a binder.

Well, the examiner did not say that either. However, silica, gravel, granite, limestone and so one disclosed in col. 6 do. These compounds are in form of aggregates and satisfy applicant's definition of stone.

b) The prior art of SALYER says nothing about encapsulating PCM material.

Hence, obviousness rejection in further view of CHEN is applied.

c) The applicants have indicated that the prior art of SALYER teaches away from using encapsulated PCM. That silica is utilized in order to increase the amount of hydrocarbon that can be added.

The prior art of SALYER does not specifically mention the term "encapsulated" but it does not mean that the prior art teaches away from encapsulating. Silica is used in the teaching of SALYER because it is porous and has ability of absorbing the other substances. This may not be called encapsulation per se, but it is functional equivalent thereof.

d) The prior art of SALYER teaches composition that is very different from that of the applicants and argues SALYER's statements directed towards amount of alkyl hydrocarbon, such that they are not utilized in amount greater than 5 %.

The prior art of SALYER discloses that the amount of alkyl hydrocarbons can be increased and that depends on the composition. In the same column that the applicants cited, and keep on reading, amounts of 10 and 20 % are listed. That amount can be further increased by the use of silica, which examiner indicated adsorbs the oils and waxes. If one keeps on reading, at

the end of col. 9/10, that amount is at least 1% and up to 50 %. Again, everything depends on the composition as well as nature of hydrocarbon. Furthermore, an entire disclosure has to be considered not only bits and pieces of it that fit the argument.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

"[A]nalysis [of whether the subject matter of claim would have been obvious] need no seek out precise teachings directed to the specific subject matter of the challenged claim, for a court to take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l v. Teleflex, Inc.* 127 S. Ct 1727, 1740-1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441, F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006)).

See *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patric Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir 2006) ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) ("Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of

obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschelle*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inference which one skilled in the art would reasonable be expected to draw therefrom …”). The analysis supporting obviousness, however, should be made explicit and should “identify reason that would have prompted a person of ordinary skill in the relevant field to combine elements” in manner claimed. *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1396.

Although the prior art of CHEN may have different composition, the encapsulation of PCM within polymer appears to have similar or equivalent effect to that of adsorbing silica. Especially, in view of advantages of the encapsulated PCMs as indicated by the examiner in the first office action on the merits (paragraph 7). The statement that the applicants have referred to as “difficult to comprehend”, is found in the “background of the invention” section of CHEN (col. 2-3). This section is therefore viewed as containing information that is well known in the art.

If the applicants feel that an interview may further advance prosecution of this application such is solicited.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/  
Primary Examiner, Art Unit 1796  
October 23, 2008